APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/818,771	03/14/1997	MOJTABA MIRASHRAFI	002784.P001	9980

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COLUMBIA IP LAW GROUP, PC
10260 SW GREENBURG ROAD
SUITE 820
PORTLAND, OR 97223

EXAMINER
NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
2664	

DATE MAILED: 11/26/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 08/818,771	Applicant(s) MIrashrafi et al.	
	Examiner Steven Nguyen	Art Unit 2664	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _Sep 4, 2001_

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-3, 5-11, 13-25, 29, and 30_ is/are pending in the applica

    4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-3, 5-11, 13-25, 29, and 30_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a)☐ All b) ☐ Some* c) ☐None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _25_

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1.　The request filed on 9/4/2001 for a Continued Prosecution Application (CPA) under 37

CFR 1.53(d) based on parent Application No. 08/818771 is acceptable and a CPA has been

established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

2.　The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

3.　Claims 1-4, 10-11 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by

Simmons (USP 5974451).

As claim 1, Simmons discloses a bridge server "Fig 4, Ref 404" for receiving a requested

information from a client for targeting a network server "Fig 1, Ref 101" and attaching additional

content "Fig 4, Ref 407, Advertisement" into a requested information for transmitting to the user

"Fig 4, Ref 410); See col 3, lines 47-66 and claim 7.

As claims 2 and 4, Simmons discloses a step of determining if any advertisements are associated with the remote information server, then selecting an advertisement to relay to the user (Fig 4, Ref 407-408); See col 3, lines 47-66 and Claim 7.

As claim 3, Simmons discloses a step of sending an additional content "advertisement" which separates from requested information "Fig 6, Ref 603-604"; See col 3, lines 47-66, claim 7.

As claims 10-11 and 17-18, Simmons discloses a bulletin information comprising hyperlink to identify the additional content information (See col 10, lines 10-24).

As claim 19, Simmons discloses a bridge server "access system of Fig 1" for receiving a request for information of targeted server "Fig 1, Ref 101", determining if any advertisements are associated with the remote information server, then selecting an advertisement to relay to the user (Fig 4, Ref 407-408) and adding the additional information "bulletin information" into requested information to provide to the user; See col 3, lines 47-66 and Claim 7 and 5.

As claims 20-21, Simmons discloses a bulletin information being mark or tag by hyperlink such as URL to allow the user to retrieve the addition information, See col 10, lines 10-24.

4.   Claims 24-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Haserodt (USP 6031836).

As claim 24, Haserodt discloses a bridge server (Fig 1, Ref 104) for receiving a request for content which targets a network server (Fig 1, 105); the bridger server 104 marks up the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for receiving a request for content of a network server 105 from user 113; the server 104 generates a mark up

request form for transmitting to the user 113; allowing the user 113 to resubmit the request the

marked up content to server 104); See col 3, lines 55 to col 4, lines 60.

As claim 25, Harerodt discloses a bridge server (Fig 2, Ref 104) removing the marked up

content after receiving a resubmitted request and forwarding the request to the server (Fig 2,

Ref 105, the server removed the requested data from the marked up form and forwards the

requested data to the server 105); See col 3, lines 55 to col 4, lines 60.

As claim 29, Haserodt discloses in Fig 2, a client including a control logic for transmitting

a request that target the server 105 and retransmitting the marked up request after receiving a

mark up form from a bridge server 104; See col 3, lines 55 to col 4, lines 60.

5.   Claims 1-4, 10-11 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by

Van Hoff (USP 5822539).

As claim 1, Van Hoff discloses a bridge server "Fig 2, Ref 118" for receiving a requested

information from a client for targeting a network server "Fig 2, Ref 104" and attaching additional

content "Fig 2, Ref 120 for merging the additional information into the requested information"

into a requested information for transmitting to the user "Fig 2, Ref 102".

As claim 2 and 4, Van Hoff discloses a step of determining if any addition contents are

associated with the remote information server, then selecting an addition content to relay to the

user (Fig 2, Ref 120 for determining if any documents are related to the requested information, if

yes, selecting the addition information for merging into the document from the server 104).

As claim 3, Van Hoff discloses a step of sending an additional content without altering

from requested information (It's implicitly shown by Van Hoff because Van Hoff does not

disclose a step of altering).

As claim 10-11 and 17-18, Van Hoff disclose an addition information comprising

hyperlink to identify the additional content information (See Fig 4).

As claim 19, Van Hoff discloses a bridge server "Fig 2, Ref 118" for receiving a request

for information of targeted server "Fig 2, Ref 104", determining if any addition contents are

associated with the remote information server, then selecting an addition content to relay to the

user (Fig 2, Ref 120) and adding the additional information into requested information to provide

to the user (Fig 2, Ref 102; See col 4, lines 58 to col 6, lines 63).

As claims 20-21, Van Hoff discloses information being mark or tag by hyperlink such as

URL to allow the user to retrieve the addition information (Fig 4).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims

under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7.   Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Haserodt as applied

to claim 29 above, and further in view of Rondeau (USP 5850433).

As claim 30, Haserolt does not disclose the claimed invention. However, Rondeau

disclosed a client system which transmits another request upon receiving an identifier of addition

content from a server "Fig 1, Ref 28"; (a client clicks on the telephone icon to talk to the

telephone 22 for addition content).

Since, Rondeau suggests a method of embedding the telephone number into a mark up

page. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to apply a telephone number into a web page as addition content for allowing

a user to contact with an agent for obtaining more information as disclosed by Rondeau into

Harserolt's communication system. The motivation would have been to prevent the human error.

8.   Claims 6-9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Simmons/Van Hoff as applied to claims 1 and 19 above, and further in view of Rondeau

(USP 5850433).

As claims 6-9 and 22, Simmons/Van Hoff fails to disclose the claim invention. Rondeau

discloses the additional content information comprising an option to make a phone call by

allowing a user to click on the icon (Fig 2, Ref 54) to make a phone call via the network to a

PSTN handset (Fig 1, Ref 22) and the addition content such as telephone number must be marked

by the access server for returning to the user in a form such as icon or button.

Since, Simmons suggests a method and apparatus for providing an advertisement via an

internet service provider. Therefore, it would have been obvious to one of ordinary skill in the art

at the time of the invention was made to apply a database server which includes a telephone icon

as disclosed by Rondeau into a bulletin server's Simmons or server's Van Hoff. The motivation

would have been to reduce the amount of time required to place a telephone to one of provider.

9.   Claims 13-16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Simmons/Van Hoff as applied to claims 1 and 19 above, and further in view of Haserodt

(USP 6031836).

As claims 13-16 and 23, Simmons/Van Hoff does not disclose the claimed invention.

However, in the same field of endeavor, Haserodt a bridge server (Fig 1, Ref 104) for receiving a

request for content which targets a network server (Fig 1, 105); the bridger server 104 marks up

the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for

receiving a request for content of a network server 105 from user 113; the server 104 generates a

mark up request form for transmitting to the user 113; allowing the user 113 to resubmit the

request the marked up content to server 104) for establishing a telephone call; See col 3, lines 55 to col 4, lines 60.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of marking up the request for transmitting to the client and allowing the client to resubmit the request as disclosed by Haserodt into Van Hoff's or Simmons' communication system. The motivation would have been to allow a client to contact with an agent in real time.

Response to Arguments

10.   Applicant's arguments filed 9/4/2001 have been fully considered but they are not persuasive.

Page 8 of the response, the applicant states that Simmons is not a prior art according to the affidavit filed on 3/12/2001. In reply, the affidavit filed on 3/12/2001 under 37 CFR 1.131 is *ineffective* to overcome to Simmons reference because the Simmons is a U.S. patent that claims the rejected invention such as claims 1-4, 10-11 and 17-21. An affidavit or declaration is *inappropriate* under 37 CFR 1.131(a) when the patent is claiming the same patentable invention, see MPEP § 2306. *The patent can only be overcome by establishing priority of invention through interference proceedings.* See MPEP Chapter 2300 for information on initiating interference proceedings and Chapter 700 section 715.04-715-06.

Page 8-10 of the response, the applicant states that VanHoff does not disclose "in addition to the content provided to the client system by the network server. In reply, Vanhoff disclose a method and apparatus for allowing a client (Fig 2, Ref 102) to submit a request for information (Fig 2, Ref 201)at a network server (Fig 2, Ref 104) via proxy server (Fig 2, Ref 119) which provides an addition information in the annotation directory 191 with information from network server 104 to client 102 wherein the annotation information has a link which is merged to the information of the network server (the supplemental information read on the additional content, See col. 5, lines 1-25 wherein the proxy will obtain a cross reference between the requested information and annotation directory to provide to client).

Pages 10-12 of the response, the applicant states that Haserodt does not disclose a bridge server, network server and client. In reply, Haserodt discloses a bridge server (Fig 1, Ref 104) for receiving a request from a client (Fig 1, Ref 101) for targeting a network server (Fig 1, Ref 105). The bridge server markup the requested for transmitting to the client for resubmitting (See Fig 2, 204-210).

The teaching of Haserodt and Vanhoff perform the claimed invention. Therefore, the rejection maintains.

Note : The application has a potential interference with the US patent 6311185.

Conclusion

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2664
November 13, 2001

WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600